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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,661	03/09/2001	Victor Keith Blanco	MS1-770US	7533
22801	7590	11/13/2006	EXAMINER	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201				NGUYEN, KIM T
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/802,661	BLANCO, VICTOR KEITH
	Examiner	Art Unit
	Kim T. Nguyen	3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 31 August 2006.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10,13-15,17-20 and 45-51 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-10,13-15,17-20 and 45-51 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 5/25/06 & 8/31/06.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

### **DETAILED ACTION**

Examiner acknowledges receipt of the amendment on 8/31/06. According to the amendment, claim 11 has been canceled, and claims 1-10, 13-15, 17-20 and 45-51 are pending in the application.

#### ***Claim Objections***

1. Claim 1 is objected to because of the following informalities:
  - a) In claims 12 and 16, the status identifier "(original)" should be corrected to "(canceled)".
  - b) In claim 1, last line, the claimed limitation "the particular game" should be corrected to "a particular game".

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. **Claims 1-10, 13 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sano (U.S. patent No. 6,309,301) in view of Shih et al (provisional application 60/201,163).**

Claim 1: Sano discloses a game console comprising a memory coupled to a processor (Fig. 6; col. 5, line 67; and col. 6, lines 1-4); and a console application configured to allow selection of audio tracks to be played depending on the event during the game (col. 13, lines 29-31). Sano does not explicitly disclose allowing a user to select audio tracks, creating one or more soundtracks and associating the soundtrack with a particular game such that a particular soundtrack is played when a particular game is launched. However, since Shih discloses allowing a user to incorporate user-personalized songs and sounds into a video game (page 1, last two paragraphs; page 3, first paragraph; page 5, lines 10-15), and since Shih discloses associating encoded tags with the sound files such as game title, etc. such that a particular soundtrack is played with a particular game (page 1, last two paragraphs; page 3, lines 3-7 and 10-19; page 4, lines 1-2; and page 6, lines 13-18), and shih obviously encompasses allowing the user to select stored audio tracks, creating a soundtrack, and associating a soundtrack with a particular game such that the sound track is played when the particular game is launched. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to configure the console application of Sano such that the console application of Sano is capable of allowing the user to select audio tracks and creating a soundtrack containing the selected audio tracks as taught by Shih in order to allow the user to incorporate the user preference songs into the game.

Claim 2 and 4-10: Sano discloses a hard disk drive (col. 11, line 23). Further, implementing a hard disk drive to a game console using a CD, DVD, game disc as a

storage medium, retrieving audio data from an online source and storing soundtrack in a memory as a WMA file, and retrieving audio tracks from audio source would have been well known to a person of ordinary skill in the art at the time the invention was made. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement a well known hard disk drive to the game console of Sano in order to facilitate storing and retrieving data to the game console.

Claim 3: Sano discloses playing soundtracks through the game console (col. 8, lines 42-46).

Claim 13: displaying a listing all available soundtracks for playback would have been old and well known to a person of ordinary skill in the art at the time the invention was made.

Claim 45: Shih discloses associating a name with a created soundtrack (page 3, lines 15-16; and page 5, line 24).

**4. Claims 14-15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sano (U.S. patent No. 6,309,301) in view of Shih et al (provisional application 60/201,163) and Goodman et al (US patent No. 6,928,433).**

Claims 14 and 18: refer to discussion in claim 1 above. Further, Goodman discloses a first user interface for facilitate selection of audio tracks (col. 2, lines 60-62), and a second user interface to facilitate playback of soundtracks (col. 9, lines 21-23). It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to include the first and the second user interface to the game console of Sano in order to allow the player to playback specific favorite soundtrack.

Claims 15 and 17: refer to discussion in claims 10-11 above.

Claims 19-20: refer to discussion in claim 13 above.

**5. Claims 46-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman et al (US patent No. 6,928,433).**

Claim 46: Goodman discloses a method comprises identifying stored audio tracks accessible by a game console (col. 7, lines 26-28; and col. 8, lines 1-8 and 59-65; col. 11, lines 14-20 and 29-30); displaying a portion of the stored audio tracks to a user (col. 2, lines 57-60); receiving information regarding selected audio tracks and creating a soundtrack (col. 2, lines 60-62). Goodman does not explicitly disclose using a game console to display a portion of the stored audio tracks, receive information regarding audio tracks selected by the user, and create soundtrack . However, Goodman suggests connecting a game console with the source device so that files from the source device can be transferred to the game console (col. 11, lines 14-20 and 29-30). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to transfer the software files from the source device to the game console for instructing the processor to perform displaying, receiving and creating a soundtrack on the game console in order to facilitate incorporating specified songs into a video game.

Claims 47-48: Goodman discloses associating a name with the soundtrack and storing the soundtrack (col. 10, line 4; col. 9, lines 8-9; col. 1, lines 49-51; and col. 2, lines 60-62).

Claims 49-51, identifying audio tracks in the game console or identifying audio tracks from an online source or a plurality of audio sources would have been well known to a person of ordinary skill in the art at the time the invention was made.

Remark:

Applicant has canceled claims 12 and 16 in the Response to Restriction/Election filed 2/14/06. The status identifiers of claims 12 and 16 should be changed to "canceled".

***Response to Arguments***

6. Applicant's arguments filed 8/31/06 have been fully considered but they are not persuasive.

a) In response to applicant's argument in page 9, second paragraph, through page 10, first paragraph, and page 12, first paragraph, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is found in the knowledge generally available

to one ordinary skill in the art. Further, since Sano discloses a gaming machine comprises a circuit board connected to a CPU and a memory (col. 5, lines 1-3), the memory stores a game application for instructing the processor to select a sound track and playing the soundtrack (col. 17, lines 4-7) and Shih discloses allowing a user to select a soundtrack, the combined teaching of Sano and Shih is proper.

- b) In response to applicant's argument in page 9, second paragraph, through page 11, Shih does discloses creating one or more soundtrack and associating the soundtrack with a particular game by associating encoded tags to the sound file such that a particular soundtrack is played when a particular game is launched (page 3, lines 3-7 and 14-19; page 6, lines 13-18).
- c) In response to applicant's argument in page 13, second paragraph, through page 14, second paragraph, since Goodman discloses a playback device comprising a processor couples to a memory, the processor is configured to perform the same functions as claimed in claim 14, since the playback system of Goodman comprises the same components and performs the same functions as the game console, the playback device of Goodman could be named as a game console. Claim 14 does not highlight any difference between the playback device of Goodman and the game console of the present application.
- d) In response to applicant's argument in page 15, refer to the U.S.C. 103(a) rejection on claim 46 above.

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action. Any response to this final action should be mailed to:

Box AF:

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Washington, D.C. 20231

Or faxed to:

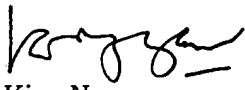
(571) 273-8300, (for formal communications; please mark  
"EXPEDITED PROCEDURE")

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is (571) 272-4441. The examiner can normally be reached on Monday-Thursday from 8:30AM to 5:00PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai, can be reached on (571) 272-7147. The central official fax number is (571) 273-8300.

kn  
Date: November 12, 2006



Kim Nguyen  
Primary Examiner  
Art Unit 3713